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Attorney Docket No. P21987

Mail Stop Appeal Brief - Patents

In re application of : David FAR'COT et al

Application No. : 10/083,492

Group Art Unit : 3618

Filed : February 27, 2002

Examiner : Christopher Bottorff

For : ASSEMBLY FOR RETAINING A BOOT ON A GLIDING BOARD

Mail Stop Appeal Brief - Patents

Commissioner for Patents

U.S. Patent and Trademark Office

Customer Service Window, Mail Stop Appeal Brief - Patents

Randolph Building

401 Dulany Street

Alexandria, VA 22314

Sir:

Transmitted herewith is a **Reply to Notification of Non-Compliance Appeal Brief** in the above-captioned application.

- Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.
- A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
- An Information Disclosure Statement, PTO Form 1449, and references cited.
- A copies of notice signed on September 10, 2004 by Robert J. Spar, for Deputy Commissioner for Patent Examination Policy; and Stephen G. Kunin, published in the Official Gazette on October 12, 2004 at 1287 O.G. 66.
- No additional fee is required.

The fee has been calculated as shown below:

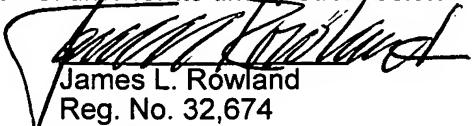
Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 40	*40	0	x 25=	\$	x 50=	\$0.00
Indep. Claims: 6	**6	0	X 100=	\$	x 200=	\$0.00
Multiple Dependent Claims Presented			+180=	\$	+360=	\$0.00
				\$		\$0.00
			Total:	\$	Total:	\$0.00

Please charge my Deposit Account No. 19-0089 in the amount of \$ _____.
 A Check in the amount of \$ _____. to cover the filing fee(s) is included.

The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

Any additional filing fees required under 37 C.F.R. 1.16.

Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136)(a)(3).


James L. Rowland
Reg. No. 32,674



USPTO

Appln. No. 10/083,492

P21987.A18 (S 885/US/Cont)

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	David FARCOT et al.)	
Appln. No.	:	10/083,492)	Group Art Unit 3618
Docket No.	:	P21987)	Examiner Christopher Bottorff
Customer No.	:	07055)	Confirmation No. 8439
Filed	:	February 27, 2002)	
Title	:	ASSEMBLY FOR RETAINING A BOOT ON A GLIDING BOARD)	

REPLY TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

U.S. Patent and Trademark Office
Customer Service Window, Mail Stop *Appeal Brief - Patents*
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Applicants herewith reply to the Notification of Non-Compliant Appeal Brief, mailed on July 13, 2005, for which the one month extendible period for reply runs to Monday, August 15, 2005.

Rather than file a new appeal brief, Applicants respectfully request that their appeal brief, filed on September 17, 2004, be accepted as in compliance with applicable U.S. Patent and Trademark Office (hereafter "Office"), as implemented at the time that appeal brief was filed. Accordingly, Applicants request that the Notification of Non-Compliant Appeal Brief be withdrawn.

A notice signed on September 10, 2004 by Robert J. Spar, for Deputy Commissioner for Patent Examination Policy, Stephen G. Kunin, published in the Official Gazette on October 12, 2004 at 1287 O.G. 66 (and available at the Office's website at www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html), a copy of which is attached, "provides clarification as to how the Office is implementing the effective date provision" (the effective date of the Rules of Practice before the Board of Patent Appeals and Interferences, provided for in 37 CFR, Part 41, having been September 13, 2004).

Therein it is explained that, "Generally, any paper filed by applicants or mailed by the Office on or after September 12, 2004 must comply with the rules as set forth in the BPAI final rule. Appeal briefs filed prior to September 13, 2004 must either comply with former §1.192 or new §41.37."

In addition, to answer specific practical situations, the notice includes a set of ten questions and answers, the sixth of which, copied below, is dispositive of the matter of Applicants' appeal brief filed on September 17, 2004:

Question 6: If an appeal brief filed before the effective date of September 13, 2004 fails to comply with the content and format requirements of §1.192 and the Office mails appellant a Notice that correction is required, would an amended appeal brief filed on or after the effective date be required to be in compliance with §41.37(c)?

Answer: No, an amended appeal brief, based on an appeal brief originally filed prior to September 13, 2004, would be acceptable if it complies with either former §1.192 or §41.37(c), regardless of when the Office mailed a Notice requiring correction of the noncompliant appeal brief.

In the instant case, Applicants first-filed an appeal brief on June 14, 2004, which prompted the Office to mail a notice entitled "Notification of Non-Compliance With 37 CFR 1.192(c)" on August 17, 2004.

In reply to the Notification of Non-Compliance With 37 CFR 1.192(c), Applicants filed a corrected appeal brief on September 17, 2004, complying with §1.192(c).

Therefore, Applicants respectfully submit that their appeal brief, filed on September 17, 2004, is consistent with the procedure set forth in the aforementioned Official Gazette notice, which provided clarification as to how the Office implemented the effective date provision of the new regulations, including that of 37 CFR §41.37.

Accordingly, Applicants request that the Notification of Non-Compliant Appeal Brief, mailed on July 13, 2005, be withdrawn.

Respectfully submitted,
David FARCOT et al.



James L. Rowland
Reg. No. 32,674

July 20, 2005
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United States Patent and Trademark Office OG Notices: 12 October 2004

Clarification of the Effective Date Provision in the
Rules of Practice before the
Board of Patent Appeals and Interferences
(Final Rule)

The effective date provision in the Rules of Practice before the Board of Patent Appeals and Interferences (Final Rule) (hereinafter BPAI final rule) states that September 13, 2004 is the effective date. See Rules of Practice Before the Board of Patent Appeals and Interferences (Final Rule), 69 Fed. Reg. 49959 (August 12, 2004). The U.S. Patent and Trademark Office (Office) has received inquiries as to how the effective date provision applies to certain situations. This notice provides clarification as to how the Office is implementing the effective date provision.

Generally, any paper filed by applicants or mailed by the Office after September 13, 2004 must comply with the rules as set forth in the BPAI final rule. Appeal briefs filed prior to September 13, 2004 must either comply with former Sec. 1.192 or new Sec. 41.37. A certificate of mailing or transmission in compliance with Sec. 1.8 will be applicable to determine if a paper was filed prior to the effective date of September 13, 2004 in order to determine which rule applies. Examples of certain situations are set forth in the questions and answers below. Additional questions and answers concerning the BPAI final rule are available on the USPTO web site at www.uspto.gov.<<http://www.uspto.gov>>

Questions related to Time Periods for Filing of Papers Related to After Final Practice and Ex Parte Appeals:

Question 1. If a notice of appeal is filed before September 13, 2004, the effective date of the BPAI final rule, when is the appeal brief due?

If the notice of appeal is filed before September 13, 2004, the time period for filing an appeal brief will be the time period set forth in former Sec. 1.192(a) which provides that the appellant must file an appeal brief: (1) within two months from the date of filing of the notice of appeal; or (2) within the time allowed for reply to the action from which the appeal was taken, if such time is later.

The time period set forth in former Sec. 1.192(a) also applies if the notice of appeal is filed with a certificate of mailing or transmission in compliance with Sec. 1.8 and the date on the certificate of mailing or transmission is before the effective date of September 13, 2004, but the notice of appeal is received by the Office on or after September 13, 2004. The two month time period will begin on the date of receipt of the notice of appeal.

Question 2. If appellant reinstates the appeal after the prosecution is reopened by filing a second notice of appeal on or after the effective date, when is the second appeal brief due?

Appellant must file the second appeal brief (in compliance with the format and content requirements of Sec. 41.37(c)) within two months from the date of filing the second notice of appeal, even if the first notice of appeal and the first brief were filed before the effective date. The two month time period is extendable under the provisions of Sec. 1.136 for patent applications and Sec. 1.550(c) for ex parte reexamination proceedings. See Sec. 41.37(e).

Question 3. If a notice of appeal is filed on or after the effective date of September 13, 2004, would extensions of time under Sec. 1.136(a) be required when a Request for Continued Examination (RCE) under Sec. 1.114 or an amendment is filed after two months from the date of filing the notice of appeal, but within three months from the mailing of the action from which the appeal was taken?

Yes, extensions of time under Sec. 1.136(a) are required for filing an RCE or amendment after two months from the filing of the notice of appeal, even if the RCE or amendment is filed within the three months from the mailing of the action from which the appeal was taken.

Questions related to Appeal Brief Contents or Requirements for Papers Filed after Appeal:

Question 4. If the notice of appeal is filed before the effective date of September 13, 2004 and the brief is filed by appellant on or after the effective date, would the appeal brief be required to comply with the content and format requirements of Sec. 41.37(c)?

Yes, any appeal brief filed on or after September 13, 2004 must be in compliance with the requirements set forth in Sec. 41.37(c) and be accompanied by the appropriate fee under Sec. 41.20(b)(2). If the brief does not comply with Sec. 41.37(c), an amended brief will be required under Sec. 41.37(d).

Exception: If the appeal brief is filed with a certificate of mailing or transmission under Sec. 1.8 and the date on the certificate of mailing or transmission is before September 13, 2004, the appeal brief may comply with either former Sec. 1.192 or new Sec. 41.37, even if the appeal brief is received by the Office on or after September 13, 2004.

Question 5. Would the Office accept an appeal brief filed before the effective date of September 13, 2004 that is in compliance with Sec. 41.37(c)?

Yes, a brief filed before September 13, 2004 that is compliant with the new Sec. 41.37(c) will be acceptable.

Question 6. If an appeal brief filed before the effective date of September 13, 2004 fails to comply with the content and format requirements of Sec. 1.192 and the Office mails appellant a Notice that correction is required, would an amended appeal brief filed on or after the effective date be required to be in compliance with Sec. 41.37(c)?

No, an amended appeal brief, based on an appeal brief originally filed prior to September 13, 2004, would be acceptable if it complies with either former Sec. 1.192 or Sec. 41.37(c), regardless of when the Office mailed a Notice requiring correction of the noncompliant appeal brief.

Question 7. If, after a final rejection or an appeal, applicant or appellant filed an amendment, affidavit or other evidence on or after the effective date, will the revised or new rules in the BPAI final rule apply?

Any affidavit or other evidence filed after a final rejection, or an appeal, on or after the effective date, will be subject to the revised or new rules (i.e., the revised Sec. 1.116 or new Sec. 41.33).

Questions related to Examiner's Answers and Supplemental Examiner's Answers:

Question 8. If the appeal brief is filed before the effective date of September 13, 2004, but the examiner's answer is mailed on or after the

effective date, can the examiner's answer include a new ground of rejection?

Yes, an examiner's answer mailed on or after September 13, 2004 may include a new ground of rejection (with Technology Center Director or designee approval) in compliance with Sec. 41.39. Any examiner's answer mailed before September 13, 2004, however, may not include a new ground of rejection. See former Sec. 1.193.

Question 9. Can the examiner provide a supplemental examiner's answer under Sec. 41.43 on or after the effective date of September 13, 2004 in response to any new issue raised in a reply brief that was filed before the effective date?

Yes, the examiner may provide a supplemental examiner's answer (with Technology Center Director or designee approval) if it is mailed on or after September 13, 2004 in response to any new issue raised in a reply brief, even if the reply brief was filed before September 13, 2004. Appellant may file another reply brief in compliance with Sec. 41.41 to reply to the supplemental examiner's answer within two months from the date of mailing of the supplemental examiner's answer.

Extensions of time under Sec. 1.136(a) are not applicable to the two-month time period.

Question 10. If the Board remanded an application before the effective date of September 13, 2004 for further consideration of a rejection, and the examiner provides a supplemental examiner's answer on or after the effective date (in response to the remand by the Board), can appellant request that prosecution be reopened under Sec. 41.50(a)(2)(i)?

No, appellant may not request that prosecution be reopened under Sec. 41.50(a)(2)(i) in response to the supplemental examiner's answer since the Board remanded the application before the effective date. Appellant may request that prosecution be reopened in response to a supplemental examiner's answer written in response to the remand by the Board, only if: (1) the remand is on or after the effective date, and (2) the remand is for further consideration of a rejection. The Board should indicate in the remand if Sec. 41.50(a)(2)(i) applies. Thus, appellant may not request that prosecution be reopened under Sec. 41.50(a)(2)(i) if the remand is for another reason.

FOR FURTHER INFORMATION CONTACT: Kery Fries, Senior Legal Advisor in the Office of Patent Legal Administration, by telephone at (703) 308-6906 or (571) 272-7704 on or after September 29, 2004, or by e-mail addressed to Kery.Fries@USPTO.gov.

STEPHEN G. KUNIN
Deputy Commissioner
for Patent Examination Policy



Clarification of the Effective Date Provision in the Rules of Practice before the Board of Patent Appeals and Interferences (Final Rule)

The effective date provision in the Rules of Practice before the Board of Patent Appeals and Interferences (Final Rule) (hereinafter BPAI final rule) states that September 13, 2004 is the effective date. See Rules of Practice Before the Board of Patent Appeals and Interferences (Final Rule), 69 Fed. Reg. 49959 (August 12, 2004). The U.S. Patent and Trademark Office (Office) has received inquiries as to how the effective date provision applies to certain situations. This notice provides clarification as to how the Office is implementing the effective date provision.

Generally, any paper filed by applicants or mailed by the Office on or after September 13, 2004 must comply with the rules as set forth in the BPAI final rule. Appeal briefs filed prior to September 13, 2004 must either comply with former § 1.192 or new § 41.37. A certificate of mailing or transmission in compliance with § 1.8 will be applicable to determine if a paper was filed prior to the effective date of September 13, 2004 in order to determine which rule applies. Examples of certain situations are set forth in the questions and answers below. Additional questions and answers concerning the BPAI final rule are available on the USPTO web site at www.uspto.gov.

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The time period set forth in former § 1.192(a) also applies if the notice of appeal is filed with a certificate of mailing or transmission in compliance with § 1.8 and the date on the certificate of mailing or transmission is before the effective date of September 13, 2004, but the notice of appeal is received by the Office on or after September 13, 2004. The two month time period will begin on the date of receipt of the notice of appeal.

Question 2. If appellant reinstates the appeal after the prosecution is reopened by filing a second notice of appeal on or after the effective date, when is the second appeal brief due?

Appellant must file the second appeal brief (in compliance with the format and content requirements of § 41.37(c)) within two months from the date of filing the second notice of appeal, even if the first notice of appeal and the first brief were filed before the effective date. The two month time period is extendable under the provisions of § 1.136 for patent applications and § 1.550(c) for *ex parte* reexamination proceedings. See § 41.37(e).

Question 3. If a notice of appeal is filed on or after the effective date of September 13, 2004, would extensions of time under § 1.136(a) be required when a Request for Continued Examination (RCE) under § 1.114 or an amendment is filed after two months from the date of filing the notice of appeal, but within three months from the mailing of the action from which the appeal was taken?

Yes, extensions of time under § 1.136(a) are required for filing an RCE or amendment after two months from the filing of the notice of appeal, even if the RCE or amendment is filed within the three months from the mailing of the action from which the appeal was taken.

Questions related to Appeal Brief Contents or Requirements for Papers Filed after Appeal:

Question 4. If the notice of appeal is filed before the effective date of September 13, 2004 and the brief is filed by appellant on or after the effective date, would the appeal brief be required to comply with the content and format requirements of § 41.37(c)?

Yes, any appeal brief filed on or after September 13, 2004 must be in compliance with the requirements set forth in § 41.37(c) and be accompanied by the appropriate fee under § 41.20(b)(2). If the brief does not comply with § 41.37(c), an amended brief will be required under § 41.37(d).

Exception: If the appeal brief is filed with a certificate of mailing or transmission under § 1.8 and the date on the certificate of mailing or transmission is before September 13, 2004, the appeal brief may comply with either former § 1.192 or new § 41.37, even if the appeal brief is received by the Office on or after September 13, 2004.

Question 5. Would the Office accept an appeal brief filed before the effective date of September 13, 2004 that is in compliance with § 41.37(c)?

Yes, a brief filed before September 13, 2004 that is compliant with the new § 41.37(c) will be acceptable.

Question 6. If an appeal brief filed before the effective date of September 13, 2004 fails to comply with the content and format requirements of § 1.192 and the Office mails appellant a Notice that correction is required, would an amended appeal brief filed on or after the effective date be required to be in compliance with § 41.37(c)?

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Question 7. If, after a final rejection or an appeal, applicant or appellant filed an amendment, affidavit or other evidence on or after the effective date, will the revised or new rules in the BPAI final rule apply?

Any affidavit or other evidence filed after a final rejection, or an appeal, on or after the effective date, will be subject to the revised or new rules (*i.e.*, the revised § 1.116 or new § 41.33).

Questions related to Examiner's Answers and Supplemental Examiner's Answers:

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Question 9. Can the examiner provide a supplemental examiner's answer under § 41.43 on or after the effective date of September 13, 2004 in response to any new issue raised in a reply brief that was filed before the effective date?

Yes, the examiner may provide a supplemental examiner's answer (with Technology Center Director or designee approval) if it is mailed on or after September 13, 2004 in response to any new issue raised in a reply brief, even if the reply brief was filed before September 13, 2004. Appellant may file another reply brief in compliance with § 41.41 to reply to the supplemental examiner's answer within two months from the date of mailing of the supplemental examiner's answer. Extensions of time under § 1.136(a) are not applicable to the two-month time period.

Question 10. If the Board remanded an application before the effective date of September 13, 2004 for further consideration of a rejection, and the examiner provides a supplemental examiner's answer on or after the effective date (in response to the remand by the Board), can appellant request that prosecution be reopened under § 41.50(a)(2)(i)?

No, appellant may not request that prosecution be reopened under § 41.50(a)(2)(i) in response to the supplemental examiner's answer since the Board remanded the application before the effective date. Appellant may request that prosecution be reopened in response to a supplemental examiner's answer written in response to the remand by the Board, only if: (1) the remand is on or after the effective date, and (2) the remand is for further consideration of a rejection. The Board should indicate in the remand if § 41.50(a)(2)(i) applies. Thus, appellant may not request that prosecution be reopened under § 41.50(a)(2)(i) if the remand is for another reason.

FOR FURTHER INFORMATION CONTACT: Kery Fries, Senior Legal Advisor in the Office of Patent Legal Administration, by telephone at (703) 308-6906 or (571) 272-7704 on or after September 29, 2004, or by e-mail addressed to Kery.Fries@USPTO.gov.

/s/ Robert J. Spar, for
Stephen G. Kunin
Deputy Commissioner
for Patent Examination Policy